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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223191
Party	Defendant Luxury Goods International (L.G.I.) S.A.
Correspondence Address	JESS M. COLLEN COLLEN IP, INTELLECTUAL PROPERTY LAW, P. 80 S HIGHLAND AVE OSSINING, NY 10562-5615 trademark@collenip.com
Submission	Motion to Dismiss - Rule 12(b)
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Signature	/Oren Gelber/
Date	09/16/2015
Attachments	R723-MOTION TO DISMISS FINAL.pdf(2954166 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

RIVE GAUCHE JEWELRY, INC.,

Opposer,

v.

LUXURY GOODS

INTERNATIONAL (L.G.I.) S.A.,

Applicant.

Mark: RIVE GAUCHE (Stylized)

Opp. No.: 91223191

Serial No.: 86327529

**APPLICANT’S MOTION TO DISMISS FOR FAILURE TO
SERVE PURSUANT TO FED. R. CIV. P. 12(B)(5)**

Pursuant to TBMP § 502.01 and Fed. R. Civ. P. 12(b)(5), Applicant, Luxury Goods International (L.G.I.) S.A. (LGI), respectfully requests the dismissal of the instant Opposition proceeding. Potential Opposer has failed to effect proper service of process.

I. FACTUAL BACKGROUND

Opposer filed a Notice of Opposition on August 7, 2015 against Applicant’s Application Serial No. 86327529. D.E. 1. The Notice of Opposition did not include a certificate of service. *Id.* The certificate of service generated by the U.S. Trademark Office’s Electronic System for Trademark Trials and Appeals (“ESTTA”) indicated that service was made “via facsimile or email (by agreement only)”. *Id.*

Neither Applicant nor Applicant’s counsel of record consented to service by email or facsimile. Declaration of Jess M. Collen (“Collen Decl.”) ¶ 6. There was no communication of any kind between the parties prior to the filing of the Notice of Opposition. *Id.* at ¶ 4.

On September 9, 2015, Applicant’s counsel advised Opposer’s in writing that it never received appropriate service of the Opposition and requested that Opposer withdraw the

Opposition. *Id.* at ¶ 7 and Exhibit B. Applicant's letter of September 9, 2015 was transmitted to Opposer's counsel via email at 11:34am and by regular mail. *Id.* at ¶ 8 and Exhibit C.

On September 10, 2015, Applicant's counsel received a copy of the Notice of Opposition by Express Mail. *Id.* at ¶ 9. The mailing receipt on the Express Mail envelope and the U.S. Postal Service Tracking Information for the Express Mail envelope dispatched by Opposer indicates that the Notice of Opposition was mailed on September 9, 2015 at 5:05pm—more than a month after the attempted filing of the Notice of Opposition and well after the close of the opposition period. *Id.* at ¶ 10 and Exhibits D and E.

Although Opposer attested to service of the Notice of Opposition, Opposer has failed to effect actual service of the Notice of Opposition upon Applicant or its attorney of record as required by the Trademark Rules. Attesting to proof of service of an ESTTA filing without actually effecting service in compliance with the Trademark Rules is insufficient to commence an opposition proceeding before the Trademark Trial and Appeal Board. *See Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008). The instant Opposition should be dismissed as a nullity due to Opposer's failure to comply with 37 C.F.R. §§ 2.101 and 2.119.

II. ARGUMENT

The requirements for proper service and proper completion of service of process in an opposition proceeding before the Trademark Trial and Appeal Board are set out in 37 C.F.R. § 2.101. A party to an opposition proceeding before the Board may raise the defense of insufficient service of process under Fed. R. Civ. P. 12(b)(5) which is made applicable to TTAB proceedings by 37 C.F.R. § 2.116(a).

Federal Rule 12(b) allows the affirmative defense of insufficient service to be presented

by motion. In order to be effective, such a motion must be timely filed. Fed. R. Civ. P. 12(b). The instant Motion to Dismiss is timely, as it is filed before Applicant's answer to the Notice of Opposition. *Id.*

Trademark Rule 2.101(a) sets out the requirements for initiating an opposition proceeding before the TTAB:

An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. The notice must include proof of service on the applicant, or its attorney or domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.101(b) and 2.119.

TBMP § 309.02(c)(1) provides that “[w]hen an opposer files its notice of opposition with the Board, the opposer must concurrently serve a copy of the opposition, including any exhibits, on the attorney of record for the applicant at the attorney's correspondence address of record in the Office.” Emphasis added; *see also* 37 C.F.R. § 2.101(b). Service may be effected via any means outlined in 37 C.F.R. §2.119(b). *See* TBMP § 309.02(c)(1). Service of the Notice of Opposition by email or facsimile is only appropriate “[i]f the parties have communicated prior to the filing of the notice of opposition, and the applicant has agreed to accept service of the complaint by electronic transmission.” *Id.* The Trademark Rules are clear that an applicant must grant specific consent to opposer for service of the pleading via facsimile or email and that “[a]uthorization by an applicant, given to the Office during prosecution, to allow the Office to communicate with applicant by email, does not by itself enable opposer to serve the notice of opposition by email.” TBMP § 309.02(c)(1).

As demonstrated by the record, Opposer failed to adhere to these service requirements. Consequently, the instant Opposition should not have been instituted and

the Board should dismiss this Opposition as a nullity. *See Springfield Inc. v XD*, 86 USPQ2d 1063, 1064 (TTAB 2008) (notice of opposition filed through ESTTA on the last day of the opposition period included a proof of service, but inasmuch as there was no actual service on applicant, opposer failed to comply with service requirement of 37 C.F.R. §§ 2.101(a) and 2.101(d)(4); notice of opposition should not have received a filing date and proceeding should not have been instituted; case dismissed as nullity); *Schott AG v. L'Wren Scott*, 88 USPQ2d 1862, 1863-64 (TTAB 2008)(opposer filed notices of opposition via first class mail that failed to include certificates of service and opposer did not dispute its failure to actually forward service copies to applicant upon filing; cases dismissed as nullities).

A. Opposer Failed to Properly Serve Applicant

The ESTTA-generated certificate of service for this Opposition indicates that Opposer effected that service was made “via facsimile or email (by agreement only)”. However, there was no agreement between the parties which permitted service by facsimile or email. *See Collen Decl.* at ¶ 6. Indeed, Opposer did not make any attempt to contact Applicant prior to the filing of the Notice of Opposition. *Id.* at ¶¶ 4-5. The Trademark Rules are clear, service of the pleading via email or facsimile is permitted only “[i]f the parties have communicated prior to the filing of the notice of opposition, and the applicant has agreed to accept service of the complaint by electronic transmission.” TBMP § 309.02(c)(1); 37 CFR § 2.119(b)(6) (service may be effected by “[e]lectronic transmission when mutually agreed upon by the parties.”); Miscellaneous

Changes to Trademark Trial and Appeal Board Rules, 72 Fed.Reg. 42242, 42248 (August 1, 2007).

The Board held in *Musical Directions v. McHugh*, 104 USPQ2d 1157, 1159 (TTAB 2012) that service by fax or email is improper where parties did not previously agree to these service methods.

In *Musical Directions*, the Board ultimately found service to be proper, despite the fact that the ESTTA certificate of service indicated that opposition was served by fax or email and there is no indication that applicant had agreed to service by email or fax, because the opposer “submitted a copy of the certified mailing receipt of the service copy of its notice of opposition, showing that the copy was served by first-class mail on May 30, 2012, within the opposition period.” 104 USPQ2d at 1159-60.

The instant case is similar to *Musical Directions* in that the ESTTA certificate of service states that Notice of Opposition was served by fax or email but Applicant did not agree to service in such a manner, as required by the Trademark Rules. *See* Collen Decl. at ¶ 6. However, and most importantly, *Musical Directions* is distinguishable from the current proceeding because the Opposer in this case did not serve the Notice of Opposition by mail within the opposition period. Rather, the Opposer belatedly provided a service copy of the Notice of Opposition over one month after the expiration of the opposition period.

The Board was able to overlook the incorrect wording of the certificate of service in *Musical Directions* because the opposer actually served the notice of opposition by mail within the opposition period. 104 USPQ2d at 1159-60. No such facts are present in this case which would permit the Board to overlook the failure of Opposer’s attempted

service. Given these facts and the case law, the Board should dismiss the Opposition as a nullity due to insufficient service.

B. Notice Cannot Cure Defective Service

Providing notice to the defendant that it is the subject of a Board proceeding is among the considerations underpinning 37 C.F.R. §§ 2.101 and 2.119, analogous to the service requirements in Fed. R. Civ. P. 4. However, Opposer's defective service and failure to comply with the Trademark Rules is not curable merely by virtue of citing Applicant's notice of these proceedings. *West v. Terry Bicycles, Inc.*, 2000 U.S. App. LEXIS 1791 (Fed. Cir. 2000) ("Although notice underpins Federal Rule of Civil Procedure 4 concerning service, notice cannot by itself validate an otherwise defective service."); *Freedom Watch, Inc. v. Org. of the Petroleum Exporting Countries OPEC*, 766 F.3d 74, 81 (D.C. Cir. 2014) (same) *Albra v. Advan, Inc.*, 490 F.3d 826, 829 (11th Cir. Fla. 2007) ("defendant's actual notice is not sufficient to cure defectively executed service."); *Grand Entertainment Group, Ltd. v. Star Media Sales, Inc.*, 988 F.2d 476, 492 (3d Cir. 1993) (same).

C. The Service Requirement is Premised Upon Additional Considerations

Furthermore, notice is not the sole basis for the Board's requirement for actual service. If notice were the only consideration, the Board would abrogate the requirement for service by the opposer under 37 C.F.R. § 2.101 and rely solely upon 37 C.F.R. § 2.105 whereby the Board provides notice to the parties, as it had done prior the 2007 Rule Change.

TBMP 309.02(c) indicates that service of pleadings is intended to facilitate communication between the parties for the purposes of “promoting possible settlement of claims and for ensuring cooperation and procedural efficiency in the early stages of a proceeding.” Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007); *see also Schott AG v. L'Wren Scott*, 88 U.S.P.Q.2D (BNA) 1862, 1863-1864 (TTAB 2008). Opposer did not make any effort to reach out to Applicant or its counsel prior to the filing of the Notice of Opposition. Collen Decl. at ¶¶ 4-5. Consequently, Opposer’s unconsented service by email was contrary to the Trademark Rules and their intended purpose of promoting early discussions amongst the parties prior to filing, more efficient initiation of proceedings or facilitation of early settlement discussions.

D. The Defect in Opposer’s Service is Not Curable

Opposer belatedly attempted to cure the defect in service by sending the Notice of Opposition to Applicant’s counsel by Express Mail on September 9, 2015. Such service is untimely and cannot cure the defect in service.

First, the Trademark Rules require that upon filing the Notice of Opposition, “the opposer must **concurrently** serve a copy of the opposition” upon the applicant. TBMP § 309.02(c)(1) (emphasis added). Opposer’s Express Mailing came over a month after the filing of the Notice of Opposition. *See* D.E. 1; Collen Decl. at ¶¶ 10 and 12 and Exhibits D and E.

In this regard, the instant case is similar to *Springfield, Inc. v. XD*, where opposer filed a Notice of Opposition through ESTTA on the last day of the opposition period with

a certificate of service indicating that it had served the applicant when in fact it did not serve the applicant on the date of filing. 86 U.S.P.Q.2D (BNA) 1063 (TTAB 2008). The opposer in that case attempted to remedy the lack of service by amending the notice of opposition to indicate that it served a copy of the notice of opposition 19 days subsequent to filing. *Springfield, Inc.*, 86 U.S.P.Q.2D (BNA) at 1064. The Board dismissed the opposition as a nullity and noted that “the requirement of the rules is for proof of service, not a promise to make service at some time in the future.” *Id.* *Springfield, Inc. v. XD* thus reaffirms the requirement for service concurrently with the filing of the Notice of Opposition. Since, in the instant case, Opposer failed to secure consent to service by email and did not properly serve pursuant to 37 C.F.R. §§ 2.101 and 2.119 concurrently with the filing of the Notice of Opposition, the Opposition should be dismissed as a nullity.

Second, Opposer’s deadline for opposition was August 8, 2015. Collen Decl. at ¶ 11 and Exhibit F. Opposer’s mailing of the Notice of Opposition came on September 9, 2015, over a month after the expiration of the stated opposition period. Opposer’s service is therefore well overdue and cannot be considered timely under any circumstance.

TTAB case law is instructive on this point. For example, in *Musical Directions*, the Board refused to dismiss the opposition despite the incorrect wording of the certificate of service because the opposer submitted evidence that the notice of opposition was served by mail within the opposition period. 104 USPQ2d at 1159-60.

In contrast, in *Schott AG v. L’Wren Scott*, opposer filed Notices of Opposition without certificates of service and failed to effect service upon the applicant, thus prompting the Board to dismiss the oppositions as nullities noting that the service defects

could not be cured because the original notices of opposition did not include proof of service and were not properly served in a timely manner. 88 U.S.P.Q.2D (BNA) 1862, 1864 (TTAB 2008).

The facts of *Schott AG* are analogous to the circumstances of the instant case. Here, Opposer's ESTTA filing asserts service was effectuated via facsimile or email despite the fact that Applicant did not agree to service in such a manner. Further, Opposer did not serve by mail within the opposition period. The incorrect certificate of service, coupled with the lack of proper service during the opposition period, amount to a failure to include proof of service and a failure to timely serve. Accordingly, the instant Opposition should be dismissed, as no opposition proceeding has been properly commenced within the statutory term.

III. CONCLUSION

Opposer failed to properly serve the Notice of Opposition upon Applicant's counsel of record. The ESTTA-generated certificate of service states that service was effectuated by fax or email. Service in such a manner is only permissible upon explicit agreement between the parties. Applicant did not agree to service by email or fax. Therefore, Opposer's service in such a manner is not proper.

The fact of Applicant's actual notice of the proceeding does not alleviate the defect in Opposer's service, as notice is not the sole purpose of service of process as noted by the Trademark Rules.

Opposer belated efforts to cure this defect in service by transmitting a service copy by Express Mail on September 9, 2015 is ineffective. Such service was accomplished outside the

opposition period and was not made concurrently upon filing of the Notice of Opposition, as required by the Trademark Rules. Given the passage of time, Opposer's failure to properly serve is incurable.

Wherefore, Applicant, Luxury Goods International (L.G.I.) S.A. (LGI), respectfully requests the dismissal of the instant Opposition proceeding as a nullity due to insufficient service pursuant to Fed. R. Civ. P. 12(b)(5).

Respectfully submitted

By: 

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*Attorneys for Applicant, Luxury Goods
International (L.G.I.) S.A.*

DATED: September 16, 2015

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-

2465.

I HEREBY CERTIFY THAT THIS MOTION TO DISMISS IS BEING FILED ELECTRONICALLY WITH THE UNITED STATE PATENT AND TRADEMARK OFFICE.

COLLEN *IP*, THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE, OSSINING, NEW YORK 10562

By: Owen Gelber

Date: September 16, 2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

RIVE GAUCHE JEWELRY, INC.,
Opposer,

v.

LUXURY GOODS
INTERNATIONAL (L.G.I.) S.A.,
Applicant.

Mark: RIVE GAUCHE (Stylized)
Opp. No.: 91223191
Serial No.: 86327529

DECLARATION IN SUPPORT OF APPLICANT'S MOTION TO DISMISS

I, Jess M. Collen, declare and state, under penalty of perjury, as follows:

1. I am an attorney at Collen IP, attorneys for the Applicant, Luxury Goods International (L.G.I.) S.A., ("Applicant") in the above referenced action. The facts set forth in this declaration are personally known to me and I have first hand knowledge thereof. If called as a witness, I could and would competently testify to all the following facts that are within my personal knowledge.

2. Applicant is the owner of U.S. Trademark Application Serial No. 86327529 which is the subject of the instant opposition.

3. Applicant's U.S. Trademark Application Serial No. 86327529 designates me as the Attorney of Record and Collen IP as the Correspondent of Record. A true and correct copy of a printout of the TSDR record for Applicant's U.S. Trademark Application Serial No. 86327529 is attached hereto as Exhibit A.

4. Neither Opposer nor its counsel of record contacted Applicant's Attorney of Record prior to the August 7, 2015 filing of the Notice of Opposition. There was no communication of any kind between the parties prior to the filing of the Notice of Opposition.

5. Opposer counsel did not contact Applicant's counsel of record to secure consent to service of the Notice of Opposition by email or facsimile.

6. Applicant never consented to service of the Notice of Opposition by email or facsimile

7. On September 9, 2015, Applicant's counsel transmitted a letter to Opposer's counsel advising that Applicant never received appropriate service of the Opposition and requesting that Opposer withdraw the Opposition. A true and correct copy of the September 9, 2015 letter is attached as Exhibit B.

8. The September 9, 2015 letter was sent by U.S. mail and a courtesy copy was transmitted via email at 11:34am on September 9, 2015. A true and correct copy of the email transmission to Opposer's counsel is attached as Exhibit C.

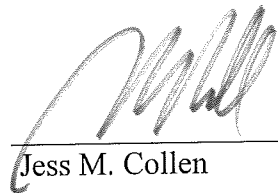
9. On September 10, 2015, Applicant's counsel received a copy of the Notice of Opposition by Express Mail.

10. The mailing receipt on the Express Mail envelope and the U.S. Postal Service Tracking Information for the Express Mail envelope dispatched by Opposer indicates that the Notice of Opposition was mailed on September 9, 2015 at 5:05pm. A true and correct copy of the Express Mail envelope containing the Notice of Opposition is attached as Exhibit D. A true and correct copy of the U.S. Postal Service Tracking Information for the Express Mail envelope containing the Notice of Opposition is attached as Exhibit E.

11. Applicant's deadline to oppose was August 8, 2015, pursuant to the Board's July 9, 2015 Order. A true and correct copy of the Board's July 9, 2015 Order is attached as Exhibit F.

12. Applicant's service by mail was effectuated on September 9, 2015, more than a month after the filing of the Notice of Opposition and more than a month after the expiration of the opposition period.

Executed September 16, 2015 at Ossining, New York.



Jess M. Collen

EXHIBIT A

Generated on: This page was generated by TSDR on 2015-09-16 17:54:38 EDT

Mark: RIVE GAUCHE

rive gauche

US Serial Number: 86327529

Application Filing Date: Jul. 02, 2014

Register: Principal

Mark Type: Trademark

Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Aug. 07, 2015

Publication Date: Jun. 09, 2015

Mark Information

Mark Literal Elements: RIVE GAUCHE

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Color(s) Claimed: Color is not claimed as a feature of the mark.

Translation: The English translation of "RIVE GAUCHE" in the mark is "LEFT BANK".

Related Properties Information

Claimed Ownership of US Registrations: 1770566, 1901788, 2383556 and others

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Spectacle frames, spectacles, sunglasses, tinted or anti-glare spectacles, protective goggles, pincenez, opera glasses, magnifying glasses, spectacle cases and containers for contact lenses; optical apparatus and instruments, namely, optical inspection apparatus, optical transmitters; correcting optical lenses; spectacle glasses, contact lenses, tinted optical lenses and filter optical lenses; protective optical lenses, magnifying lenses, optical lenses; apparatus for recording, transmission or reproduction of data, sound or images; telephones, mobile telephones, smartphones, video phones, tablet computers, PDAs (personal digital assistants) and MP3 players; accessories for telephones, mobile telephones, Smartphones, video phones, tablet computers, PDAs (personal digital assistants) and MP3 players, namely, hands-free kits for telephones, batteries, covers, cases, fascias, battery chargers, mobile phone straps, wrist or neck straps; electronic handheld units for the wireless transmission of data and/or voice signals; accessories for electronic handheld units for the wireless transmission of data and/or voice signals, namely, batteries, hands free car kits for the adaptation of portable communication apparatus and instruments for vehicular use, battery chargers and charging pods, headsets, clips and cases for fixing mobile telephones, Smartphones, video phones, MP3 players, PDAs (personal digital assistants) to belts, headphone sets, adapters, adapters cases, desk stands adapted for electronic handheld units; electronic docking stations, computer cables, cases and covers for portable computers, covers adapted for electronic handheld units, battery housings; blank magnetic data carriers, blank recording discs, blank compact discs, blank DVDs, blank USB flash drives and digital recording media; data processing equipment; computers; computer software to enable connection to databases, local area networks and the Internet, teleconferencing, videoconferencing and videophone services, searching and retrieval of data; computer software for accessing databases, telecommunications services, computer networks and electronic bulletin boards; computer screen saver software and screen wallpaper software; downloadable computer software and mobile applications for aggregating, accessing, providing, creating, managing and sharing information and other digital content in the fields of fashion, beauty, shopping, lifestyle, entertainment and health; providing downloadable computer software and mobile application enabling users to participate in discussions, share messages, images and other digital content, form virtual communities, and engage in social networking; mechanisms for coin-operated apparatus; cash registers, calculating machines; fire-extinguishing apparatus; scientific apparatus and instruments not for medical purposes, namely, optical mirrors, cameras, digital cameras, television apparatus for projection purposes, television sets, radios; nautical, surveying, photographic, cinematographic, weighing, measuring, signaling, supervising, life-saving and teaching apparatus and instruments, namely, spectrometers, underwater enclosures for cameras, tripods, cameras, optical cables, scales, measuring tapes, optical signaling cables, life vests, life rafts and medical teaching mannequins; cases adapted for photographic and cinematographic apparatus

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(b)

For: Precious metals and their alloys; works of art of precious metal; jewelry, including costume jewelry, of precious metals; jewelry of alloys and plated, namely, rings, earrings, cuff links, bracelets, brooches, pendants, charms, jewelry chains and watch chains, necklaces, medals, and medallions; semi-precious stones and precious stones; horological and chronometric instruments, watches, watch bands and watch cases; key rings of precious metals, of alloys or plated; presentation cases for watches; cases for clock making and watchmaking; jewelry cases and jewelry caskets

International Class(es): 014 - Primary Class

U.S Class(es): 002, 027, 028, 050

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use:	No	Currently Use:	No	Amended Use:	No
Filed ITU:	Yes	Currently ITU:	Yes	Amended ITU:	No
Filed 44D:	No	Currently 44D:	No	Amended 44D:	No
Filed 44E:	No	Currently 44E:	No	Amended 44E:	No
Filed 66A:	No	Currently 66A:	No		
Filed No Basis:	No	Currently No Basis:	No		

Current Owner(s) Information

Owner Name: Luxury Goods International (L.G.I.) S.A.

Owner Address: Via Industria 19
6814 Cadempino
SWITZERLAND

Legal Entity Type: CORPORATION

State or Country Where
Organized: SWITZERLAND

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jess M. Collen
Attorney Primary Email Address: trademark@collenip.com
Docket Number: Q791
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JESS M. COLLEN
COLLEN IP, INTELLECTUAL PROPERTY LAW, P.
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OSSINING 10562-5615
Phone: (914) 941-5668
Correspondent e-mail: trademark@collenip.com
Fax: (914) 941-6091
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 07, 2015	OPPOSITION INSTITUTED NO. 999999	223191
Jul. 09, 2015	EXTENSION OF TIME TO OPPOSE RECEIVED	
Jun. 09, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 09, 2015	PUBLISHED FOR OPPOSITION	
May 20, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 05, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	68552
May 01, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 16, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	68552
Apr. 16, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	68552
Apr. 15, 2015	ASSIGNED TO LIE	68552
Apr. 10, 2015	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 08, 2015	ASSIGNED TO EXAMINER	76737
Oct. 14, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Oct. 14, 2014	NON-FINAL ACTION E-MAILED	6325
Oct. 14, 2014	NON-FINAL ACTION WRITTEN	82104
Oct. 10, 2014	ASSIGNED TO EXAMINER	82104
Jul. 09, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 05, 2014	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: NEVILLE, JAMES B

Law Office Assigned: LAW OFFICE 114

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: May 05, 2015

Proceedings

Summary

Number of Proceedings: 2

Type of Proceeding: Opposition

Proceeding Number: [91223191](#)

Filing Date: Aug 07, 2015

Status: Pending

Status Date: Aug 07, 2015

Interlocutory Attorney: MIKE WEBSTER

Defendant

Name: Luxury Goods International (L.G.I.) S.A.

Correspondent Address: JESS M. COLLEN
COLLEN IP, INTELLECTUAL PROPERTY LAW, P.
80 S HIGHLAND AVE
OSSINING NY , 10562-5615

Correspondent e-mail: trademark@collenip.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
RIVE GAUCHE	Opposition Pending	86327529	
Plaintiff(s)			

Name: Rive Gauche Jewelry Inc.

Correspondent Address: Ursula B. Day
Law firm of Ursula B. Day
708 Third Avenue Suite 1501
New York NY , 10017
UNITED STATES

Correspondent e-mail: patentlaw@ursuladay.net

Associated marks

Mark	Application Status	Serial Number	Registration Number
RIVE GAUCHE JEWELRY			

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 07, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 07, 2015	Sep 16, 2015
3	PENDING, INSTITUTED	Aug 07, 2015	

Type of Proceeding: Extension of Time

Proceeding Number: [86327529](#)

Filing Date: Jul 09, 2015

Status: Terminated

Status Date: Aug 08, 2015

Interlocutory Attorney:

Defendant

Name: Luxury Goods International (L.G.I.) S.A.

Correspondent Address: JESS M. COLLEN
COLLEN IP, INTELLECTUAL PROPERTY LAW, P.
80 S HIGHLAND AVE
OSSINING NY , 10562-5615

Associated marks

Mark	Application Status	Serial Number	Registration Number
RIVE GAUCHE	Opposition Pending	86327529	
Potential Opposer(s)			

Name: Rive Gauche Jewelry Inc.

Correspondent Address: Ursula B. Day

Law firm of Ursula B. Day
708 Third Avenue Suite 1501
New York NY , 10017
UNITED STATES

Correspondent e-mail: patentlaw@ursuladay.net

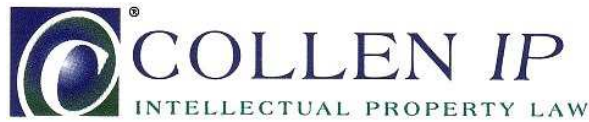
Associated marks

Mark	Application Status	Serial Number	Registration Number
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Prosecution History

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Jul 09, 2015	
2	EXTENSION OF TIME GRANTED	Jul 09, 2015	

EXHIBIT B



Te le pho ne (914) 941-5668

Fac simile (914) 941-6091

www.colle nIP.com

Email: jcollen@collenIP.com

September 9, 2015

BY U.S. MAIL

CONFIRMATION BY EMAIL: patentlaw@ursuladay.net

Law firm of Ursula B. Day
708 Third Avenue, Suite 1501
New York, New York 10017
Attn: Ms. Ursula B. Day

RE: U.S. Trademark Opposition No. 91223191
Rive Gauche Jewelry, Inc. v Luxury Goods International (L.G.I.) S.A.
Serial No. : 86327529

Mark : *rive gauche* 
Your Ref. :
Our Ref. : R723

Dear Ms. Day:

As you know, this firm is intellectual property counsel to Luxury Goods International (L.G.I.) S.A. ("LGI"). I write to address a few points related to U.S. Opposition No. 91223191 initiated by your client, Rive Gauche Jewelry, Inc.

First, with regard to the Notice of Opposition filed August 7, 2015, we note that the certificate of service generated by the Trademark Trial and Appeal Board indicates that service was made "via facsimile or email (by agreement only)". However, our firm never consented to service by email. In fact, neither you nor your client contacted us prior to the filing of the Notice of Opposition to secure our consent to service by email. Absent our consent to service by email or facsimile, it was incumbent upon you to serve LGI's correspondent of record (Collen IP) by U.S. mail, express mail or other means designated by 37 CFR § 2.119.

To date, we have not received a service copy of the Notice of Opposition by mail. Accordingly, service of the Notice of Opposition is insufficient pursuant to the Trademark Rules. TBMP 309.02(c)(1); 37 CFR §§ 2.101(a) and 2.101(d)(4).

Under these facts, we believe it is incumbent upon you, given this misrepresentation in the certificate of serve filed with the United States Patent and



Trademark Office, to withdraw this pleading at once. If Opposer is unwilling to dismiss the Opposition, we will move to dismiss on all appropriate grounds.

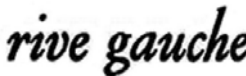
Further, the facts at hand establish that Applicant, rather than Opposer, has priority of right with regarding the mark RIVE GAUCHE.

LGI owns all U.S. rights, title and interest in a number of trademarks, including United States Trademark Registration Nos. 1680439; 1699148; 1770566; 1901788; and

2383556, and others, for the marks , YVES SAINT LAURENT RIVE GAUCHE, RIVE GAUCHE and  (the RIVE GAUCHE Marks).

LGI has used the RIVE GAUCHE Marks in the U.S. since at least as early as 1968, and in some instances as early as 1966, for a variety of goods, including those in Classes 9, 14, 18 and 25. We provide herewith evidence of LGI's use of the RIVE GAUCHE Marks for your convenience.

Given its well-known use of the RIVE GAUCHE Marks on jewelry and highly related goods and services, LGI is surprised that Rive Gauche Jewelry, Inc. initiated an opposition

against its Application Serial No. 86327529 for the mark  premised on a claim of priority from July 1, 2013, and therefore must request that Opposer not only withdraw the baseless opposition, but immediately stop actively infringing upon LGI's RIVE GAUCHE Marks. LGI has reviewed information relevant to Rive Gauche Jewelry, Inc. and discovered that your client has adopted the RIVE GAUCHE mark as part of its corporate name and that it is advertising, offering for sale and selling jewelry under the mark RIVE GAUCHE, including through the website www.rivegauchejewelry.com. Opposer's advertising, sale and offering for sale of products under the RIVE GAUCHE mark violates LGI's rights under the Lanham Act. Further the domain name RIVEGAUCHEJEWELRY.COM is confusingly similar to LGI's RIVE GAUCHE Marks. Your client's conduct is likely to create a false impression of affiliation with LGI and the famous Yves Saint Laurent Fashion House and is also likely to lead to misdirected website traffic. Rive Gauche Jewelry, Inc.'s conduct dilutes the distinctive nature of LGI's RIVE GAUCHE Marks.

Your client's unauthorized use of LGI's RIVE GAUCHE Marks has caused and continues to cause irreparable harm to LGI and its RIVE GAUCHE Marks. In order to avoid further damage to LGI's valuable intellectual property rights, Opposer must immediately cease and desist from advertising, selling, offering for sale, and supplying any products or services under the mark RIVE GAUCHE. We further demand that Opposer cease any and all use of the term RIVE GAUCHE as a corporate name and as a domain name.

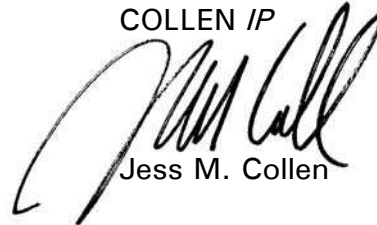
Ms. Day
September 9, 2015
Page 3 of 3 – R723

Our client is determined to fully enforce and protect all of the rights provided to it under the Trademark Laws of the United States. This letter is being sent without prejudice to any such rights. If you wish to resolve this matter amicably, please provide me with your assurances by **September 11, 2015** that Opposer will:

1. Dismiss the instant opposition with prejudice; and
2. Cease any and all use of the RIVE GAUCHE Mark, including its use as a Corporate name and as a domain name.

We look forward to working with you to quickly resolve this matter.

Very truly yours,
COLLEN /P



Jess M. Collen

JMC/OG:pm

Enclosure: Printouts showing LGI's RIVE GAUCHE Marks applied to jewelry
P:\R\R7\R723_Letter to Ms. Day re Rive Gauche_150903.DOC





YVES SAINT LAURENT
■ rive gauche ■











YVES SAINT LAURENT
■ rive gauche ■







EXHIBIT C

From: [Peter Mulhern](#) on behalf of [Jess Collen](#)
To: patentlaw@ursuladay.net
Subject: URGENT: RIVE GAUCHE opp 91223191 Rive Gauche Jewelry, Inc. v Luxury Goods International (L.G.I.) S.A.
Date: Wednesday, September 09, 2015 11:33:40 AM
Attachments: [R723 Letter to Ms. Day re Rive Gauche 150909.PDF](#)
[R723 Examples of Use of RIVE GAUCHE on Jewelry 150908.docx](#)
Importance: High

Our Ref.: R723

Dear Ms. Day,

Please see the attached correspondence from Jess Collen.

A hard copy is also being sent to you by mail.

Very truly yours,
Peter Mulhern
Legal Assistant for Jess M. Collen

COLLEN *IP*

INTELLECTUAL PROPERTY LAW, P.C.

The Holyoke-Manhattan Building

80 South Highland Avenue | Ossining-on-Hudson, Westchester County, New York 10562 | U.S.A.

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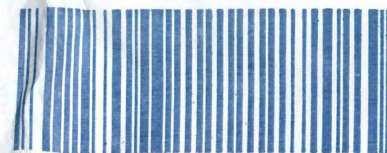
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Jess M. Callen
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September 10, 2015 , 6:33 am	Arrived at Post Office	OSSINING, NY 10562
September 10, 2015 , 3:07 am	Arrived at USPS Destination Facility	WHITE PLAINS, NY 10610
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EXHIBIT F

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Ursula B. Day
Law firm of Ursula B. Day
708 Third Avenue Suite 1501
New York, NY 10017

Mailed: July 9, 2015

Serial No.: 86327529
ESTTA TRACKING NO: ESTTA682788

The request to extend time to oppose is granted until **8/8/2015** on behalf of potential opposer **Rive Gauche Jewelry Inc.**

Please do not hesitate to contact the Trademark Trial and Appeal Board at (571)272-8500 if you have any questions relating to this extension.

Note from the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, petition for cancellation, notice of ex parte appeal, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

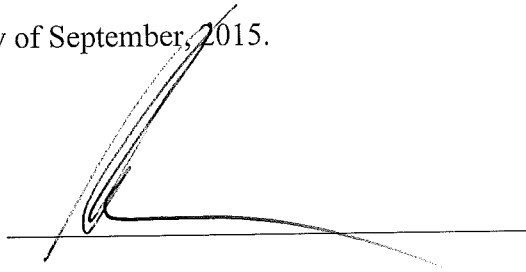
CERTIFICATE OF SERVICE

I, Peter Mulhern, hereby certify that I caused a true and correct copy of the foregoing MOTION TO DISMISS to be served upon Opposer's Attorney of Record at the following address:

Law firm of Ursula B. Day
708 Third Avenue, Suite 1501
New York, New York 10017
Attn: Ms. Ursula B. Day

Via first-class mail, postage pre-paid, and by e-mail.

Said service having taken place this 16th day of September, 2015.

A handwritten signature in black ink, appearing to be 'JMC', is written over a horizontal line.

JMC/OG:pm

P:\R\R7\R723_Applicant's Motion to Dismiss_150914.docx